

MAY 05 2006

REMARKS

Applicant has carefully reviewed the final office action mailed March 8, 2006 and offers the following remarks.

Before addressing the rejections, Applicant provides a brief summary of the present invention so that the remarks relating to the rejections are considered in the proper context. The present invention is designed to act as an effective proxy for a telephone and multimedia device so that a network would perceive the two elements as a single device. The combined user agent (CUA), however, has a telephony switch between the combined user agent and the telephone (see Figures 1-4, wherein the CUA 14 has switch 24 between the CUA 14 and the telephone 22). Thus, to establish a connection with the telephone, the CUA has to make the connection through the telephony switch.

In contrast, Tonnby et al. (hereinafter "Tonnby") is really directed to a different invention. Tonnby is aimed at using IP transport in lieu of the PSTN (see "Technical Field and Background" section of Tonnby). Tonnby is directed to a network terminal and an IP access node in an access network where IP is used as an internal multiplexing and transport technique, thereby allowing data to be transferred at a speed limited only by the modem technique used, and not by the restrictions posed by the PSTN (Abstract). In the invention of Tonnby, there will be an "always on" IP connection between the user's network terminal and the IP access server such that the problem with long duration and low utilization of the available bandwidth of dialed up Internet access over the PSTN is eliminated. According to the invention of Tonnby, the Internet access traffic will not enter the PSTN and the risk of congestion in the PSTN is non-existent (col. 5, lines 26-33). In describing how the access network of Tonnby in Fig. 10 handles the telephony application, Tonnby teaches that the basic principle is that communication to/from the telephony server 9 and to/from the network terminal 28 is performed by IP (Tonnby, col. 12, lines 3-6).

Claims 1-6, 9-15, 18-24, and 27 were rejected under 35 U.S.C. § 102(e) as being anticipated by Tonnby. Applicant respectfully traverses. For the Patent Office to prove anticipation, the Patent Office must show where each and every element of the claim is shown in the reference. Furthermore, the elements of the reference must be arranged as claimed. MPEP § 2131.

In its previous response, Applicant argued that Tonnby does not teach the claim element of the control system adapted to “communicate with a circuit-switched telephony switch to establish a connection with the telephone **through** the circuit-switched telephony switch . . .” (emphasis added). The Patent Office had previously asserted that the control system is Tonnby’s element 24, the telephone is element 5 of Figure 4 of Tonnby, and that the telephone coupled with the PSTN 2 of Figure 4 shows this element. However, the arrangement of Tonnby’s Figure 4 does not correspond to the claim language. That is, the claim requires that the connection be established through the telephony switch to the telephone. In contrast, element 24 is positioned between the telephone 5 and the PSTN 2 in Figure 4. Thus, it is not possible that the control system can establish a connection to the telephone 5 **through** the PSTN 2. Since the claim clearly recites that the connection must be established **through** the telephony switch to the telephone, and the reference shows that such an arrangement is not possible, Tonnby cannot anticipate claim 1.

In the Final Office Action, the Examiner responds and states that cols. 7 and 8 of Tonnby “teaches how the connection between the telephone and the PSTN through the telephony server and Fig. 10 also teaches the telephone 5 communicate with PSTN 2. Therefore, the connection between telephone and the PSTN through the switch can be established.” (Final Office Action mailed March 8, 2006, p. 5).

Applicant respectfully traverses. Applicant has studied cols. 7 and 8 and sees no teaching of a control system adapted to “communicate with a circuit-switched telephony switch to establish a connection with the telephone **through** the circuit-switched telephony switch,” as required by claim 1. Col. 7, lines 19-31 describes Figure 4 and discloses how an incoming call is received by the PSTN interface of the telephony server, where the telephony server digitizes and packetizes the incoming speech, provides it with a call identifier, puts it into IP packets, and provides the IP packets with the internal IP address of the network terminal and the port number of the telephony application in Fig. 10. This section of Tonnby discloses how the telephony server handles a call received at the PSTN interface of the telephony server; it does not teach a control system adapted to “communicate with a circuit-switched telephony switch to establish a connection with the telephone **through** the circuit-switched telephony switch,” as required by claim 1. The telephony server of Tonnby is not a circuit-switched telephony switch (see col. 9, lines 2-13 and col. 11, line 60 through col. 12, line 6, describing the telephony server).

Col. 7, lines 32-50 of Tonnby describes how control signaling associated with the incoming call is described in Fig. 10. This whole section is directed to handling incoming IP traffic; the only mention of the PSTN is discussing if there is an incoming call from the PSTN simultaneously with incoming IP packets from the Internet. There is no mention of a control system adapted to “communicate with a circuit-switched telephony switch to establish a connection with the telephone **through** the circuit-switched telephony switch,” as required by claim 1.

Col. 7, lines 54-63 of Tonnby describes control signaling for outgoing traffic. Once again, this passage is concerned with the network terminal converting speech to IP packets, wherein the IP packets are ultimately sent to the telephony server where they are depacketized and subjected to a D/A conversion. The result is an analog signal that is sent to the PSTN. However, there is no teaching of a control system adapted to “communicate with a circuit-switched telephony switch to establish a connection with the telephone **through** the circuit-switched telephony switch,” as required by claim 1.

The element of Tonnby that connects to the PSTN is the telephony server. Even Fig. 10, which was cited by the Examiner, shows that the telephone 5 communicates with the PSTN through the telephony server (see also col. 7, lines 32-50, which describes Fig. 10), and not “**through** the circuit-switched telephony switch,” as required by claim 1. In describing how the access network in Fig. 10 handles the telephony application, Tonnby teaches that the basic principle is that communication to/from the telephony server 9 and to/from the network terminal 28 is performed by IP (Tonnby, col. 12, lines 3-6). Thus, telephony communication in Tonnby is not done **through** the circuit-switched telephony switch. Accordingly, Tonnby does not anticipate claim 1.

Since Tonnby does not teach the claimed element of a control system adapted to “communicate with a circuit-switched telephony switch to establish a connection with the telephone **through** the circuit-switched telephony switch,” as required by claim 1, it cannot anticipate claim 1. This is not surprising considering that the teachings of Tonnby are really directed to a different invention; i.e., using IP transport in lieu of the PSTN such that traffic is not routed over the PSTN. Given that Tonnby handles the telephony application by teaching that communication to/from the telephony server 9 and to/from the network terminal 28 is performed by IP (Tonnby, col. 12, lines 3-6), it follows that Tonnby does not teach a control system adapted

to “communicate with a circuit-switched telephony switch to establish a connection with the telephone through the circuit-switched telephony switch.”

Claims 2-6 and 9 depend from claim 1 and are not anticipated at least for the same reasons.

Claim 10 recites essentially the same element, albeit in method form. As such, claim 10 is not anticipated. Claims 11-15 and 18 depend from claim 10 and are not anticipated at least for the same reasons.

Claim 19 recites essentially the same element, albeit in a software format. As such, claim 19 is not anticipated. Claims 20-24 and 27 depend from claim 19 and are not anticipated at least for the same reasons.

Claims 7, 8, 16, 17, 25, and 26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Tonnby in view of Schuster et al. (hereinafter “Schuster”). Applicant respectfully traverses. For the Patent Office to combine references in an obviousness rejection, the Patent Office must prove that there is a suggestion to combine the references. To prove that there is a suggestion to combine the references, the Patent Office must do two things. First, the Patent Office must state a motivation to combine the references, and second, the Patent Office must support the stated motivation with actual evidence. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Even if the combination is proper, to establish *prima facie* obviousness, the Patent Office must show where each and every element of the claim is taught or suggested in the combination. MPEP § 2143.03.

Applicant initially traverses the rejection because the Patent Office has not properly supported the motivation to combine the references. In particular, the Patent Office asserts that the motivation is “to implement the session initiation protocol for setup communication in the network.” (Office Action mailed September 19, 2005, page 5, lines 8-9). This asserted motivation lacks the requisite evidence. Since the motivation lacks the required evidence, the motivation is improper. Since the motivation is improper, the combination is improper. Since the combination is improper, the rejection is improper. Since the rejection is improper, the Patent Office has not established obviousness, and the claims are allowable. Applicant requests withdrawal of the § 103(a) rejection on this basis.

Applicant further traverses the rejection because the combination does not teach or suggest that the connection is made through the telephony switch to the telephone. As explained

above, Tonnby does not teach or suggest this element. Nothing in Schuster cures the deficiencies of Tonnby. Since the references individually do not teach or suggest the claim element, the combination of references cannot teach or suggest the claim element. Since the combination does not teach or suggest the claim element, the combination does not establish obviousness. Since the combination does not establish obviousness, the claims are allowable. Applicant requests withdrawal of the § 103(a) rejection on this basis, as well.

Applicant requests reconsideration of the rejections in light of the remarks presented herein. Applicant earnestly solicits claim allowance at the Examiner's earliest convenience. The Examiner is encouraged to contact Applicant's representative regarding any remaining issues in an effort to expedite allowance and issuance of the present application.

Respectfully submitted,

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